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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re U.S. Patent Application)

Applicants: Kikuchi et al.)

Serial No. 10/720,996)

Conf. No. 3391)

Filed: November 24, 2003)

For: HEAD SUSPENSION ASSEMBLY)
HAVING SMALLER STRAY)
CAPACITANCE)

Art Unit: 2652)

Examiner: Renner, Craig A.)

I hereby certify that this paper is being deposited with the United States Postal Service as FIRST-CLASS mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this date.

November 22, 2004

Date

F-CLASS.WCM

Appr. February 20, 1998

[Signature]
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RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Mail Stop AMENDMENT
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response the Election/Restriction Requirement mailed October 21, 2004, Applicants elect Group II (claims 5-9), with traverse. The grounds for traversal are that the Examiner has not established that the identified combination and subcombinations are distinct under Section 806.05(c) of the MPEP, and because no serious burden would be imposed upon the Examiner to examine all of the claims together.

Section 806.05(c) of the MPEP requires that the Examiner demonstrate two-way distinctness between an identified combination and subcombination to establish that the combination and subcombination inventions are distinct. To demonstrate two-way distinctness, the Examiner must be able to show that both: (A) the combination as claimed does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness); and (B) the subcombination can be shown to have utility either by itself or in other and different relations. Applicants submit that the Examiner has not shown that both of these required factors are present in the outstanding Restriction.

For example, the Examiner asserts that the Group III combination (independent claim 10 and its dependent claim 11) does not require the particulars of the Group II subcombination (independent claim 5 and its dependent claims 6-9) only because the respective subject matter of the dependent claims 7-9 are not recited in one of claims 10 or 11. Applicants take specific note, however, that the Examiner's rationale here neglects to consider the subject matter of the only independent claim in Group II — claim 5 — from which claim 9 depends, or the subject matter of claim 6, which also depends from claim 5, and from which both claims 7 and 8 depend. The lack of consideration of the subject matter of the independent claim and intervening claim 6 thus render the Examiner's demonstration of two-way distinctness fatally deficient.

Applicants submit that it is inappropriate for the Examiner to consider only the narrowest dependent claims (7-9) of the subcombination, while neglecting all of the subject

matter of the base claims (5-6) of the subcombination. The Examiner has not, for example, asserted that dependent claims 7-9 are patentably distinct from claims 5 and 6. Therefore, in order to satisfy the requirements of the first prong of Section 806.05(c), the Examiner was required to demonstrate that the combination as claimed does not require the particulars of all of the claims of the identified subcombination to show novelty and unobviousness. Because the Examiner has not even asserted that claim 10 of Group III does not require the particulars of claim 5 of Group II, the Election/Restriction Requirement must be withdrawn.

Additionally, Applicants further point out that, without regard to the respective preambles of the claims, all of the subject matter of independent claim 5 appears in independent claim 10. The only substantive difference between claims 5 and 10 therefore, is the additional element in claim 10 related to a swinging arm, which was noted by the Examiner. Accordingly, to further satisfy Section 806.05(c), the Examiner must have been able to show that claim 10, as claimed, does not require any of the recited subject matter in common with claim 5 for patentability. In other words, the Examiner must be able to declare on the record at this stage of prosecution that the swinging arm element of claim 10, and its recited features, alone contain allowable subject matter, and without any of the particulars in common with claim 5. Because the Examiner has not gone on record to declare that the swinging arm features of claim 10 alone render the claim patentable, the first prong of Section 806.05(c) has not been demonstrated, and should therefore be withdrawn for at least these reasons as well.

A similar problem exists in comparing claim 11 of Group III with claim 6 of Group II. Claims 11 and 6 both respectively recite generally the same subject matter, and therefore modify their respective base claims in the same way. The Examiner's assertions that claims 10 and 11 do not require the respective subject matters of claims 7-9 is irrelevant to the Restriction, because the subject matters recited in claims 7-9 could easily be added to depend from claims 10 and 11 similarly to how claims 7-9 already depend from claims 5 and 6. Such a redundancy in the dependent claim languages alone would thus render the Examiner's reasoning moot.

Because the Examiner's rationale for restricting Group I (independent claim 1, and its dependent claims 2-4) from Group III is essentially identical to his rationale for restricting Group II from Group III, Applicants submit that the Election/Restriction Requirement under Section 806.05(c) is equally deficient with respect to the relationship between Groups I and III. Unless the Examiner is prepared to further declare on the record that the read signal amplifier circuit recited in claim 1 renders claim 1 patentably distinct from the dedicated read IC chip featured in claim 5, the Election/Restriction Requirement between Groups I and III should also be withdrawn.

The Election/Restriction Requirement should also be withdrawn because no serious burden would be imposed upon the Examiner in examining all of the claims together.

As discussed above, essentially all of the subject matter of independent claim 5 appears in independent claim 10. Accordingly, to fully examine claim 10, the Examiner would still

have to perform all of the same search and review that is required to examine claim 5. No additional effort would therefore be required by the Examiner to examine claim 5 in addition to claim 10. The Election/Restriction Requirement should therefore be withdrawn for at least these additional reasons as well.

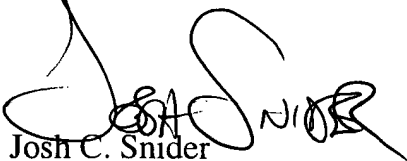
Lastly, Applicants submit that the same, or at least a similar, search and review is required to examine Groups I and II together. As noted by the Examiner, these two identified groups contain many features in common, and therefore a thorough search and review of both groups will at least overlap in many respects, and even if the Examiner makes the determination, discussed above, that the differences between independent claims 1 and 5, for example, render the two claims patentably distinct from one another.

For all of the foregoing reasons, Applicants respectfully request that the Election/Restriction Requirement of claims 1-11 be withdrawn. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

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By



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